

REMARKS

Continued Examination Under 37 CFR 1.114

Applicant acknowledges that the submission under 37 CFR 1.114 for continued examination has been entered.

Withdrawn Rejections

Applicant acknowledges that the nonstatutory obviousness double patenting rejection of claims 3, 5, 6, 8-13, 17 and 18 over allowed claims 1-6, 8-15, 17 and 19 of co-pending Application No. 10/852,404 has been withdrawn in light of the terminal disclaimer of August 02, 2007.

Claim Amendments

Claims 3, 5, 6, 8-13, 17 and 18 are pending.

Claim 5 has been amended to delete the formula " $\text{NR}'\text{SO}_2\text{R}^7$ " as a substitution on R^3 and replaced with " $\text{NR}'\text{SO}_2\text{R}^6$ ".

Claim 5 has been amended to include the definition R^6 as $(\text{C}_1\text{-C}_6)$ alkyl from the base claim 18.

Claim objections

1) The Examiner objected to Claim 5 under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. The Examiner noted that claim 5 depends on claim 18, but recites " $\text{NR}'\text{SO}_2\text{R}^7$ " as a substituent on R^3 which is not the same as " $\text{NR}'\text{SO}_2\text{R}^6$ " recited in claim 18 since R^6 and R^7 do not have the same scope.

To address the objection applicant has amended claim 5 to correct the typographical error to recite " $\text{NR}'\text{SO}_2\text{R}^6$ ". Support for the amendment is found in claim 18 as previously presented and the R^3 substituents as defined in the specification as originally filed (page 3, paragraph 64).

2) The Examiner objected to claims 3, 6, 8 and 11 as being dependent upon a rejected base claim, but noted they would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Applicant respectfully submits that in view of the arguments presented below with respect to the rejection raised for claim 18 the objection is moot.

Claim Rejections

35 USC § 102

The Examiner rejected claims 9,10,13,17 and 18 under 35 U.S.C. 102(e) as being allegedly anticipated by Bernardelli et. al. (Pub. No. US 2002/0198198).

The Examiner alleges that while the applied reference (US 2002/0198198) has a common inventor with the instant application it has a different assignee and as such constitutes 102(e) prior art.

Applicant respectfully submits that according to the Offices Assignment Records the present application and US 2002/0198198 have both common inventors and a common assignee, Warner Lambert, and the rejection is therefore improper.

The Examiner asserts that on page 24 of PP' 198, the compound in paragraph [0764] (or 8'-Chloro-5'-[2- (carboxymethyl-amino)-ethoxy]-spiro[cyclohexane-1-4'-(3',4'-dihydroquinazolin)-2'-(1'H)-one hydrochloride) reads on the instant formula (I) with the following substituents:

R¹ is Chloro;

R² is a substituent from group (c), or an alkyl group substituted with -

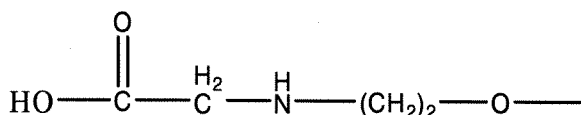
NR^aCOOR^{4a}, wherein R^a is CH₃, and R^{4a} is hydrogen.

Regardless of the status of US 2002/0198198 it is not anticipatory of the present invention.

The Examiner alleges that the compound, 8'-Chloro-5'-[2- (carboxymethyl-amino)-ethoxy]-spiro[cyclohexane-1-4'-(3',4'-dihydroquinazolin)-2'-(1'H)-one hydrochloride), of US 2002/0198198 reads on the instant formula (I) with the following substitution at R²:

C₂ alkyl substituted with -NR^aCOOR^{4a}, wherein R^a is CH₃, and R^{4a} is hydrogen.

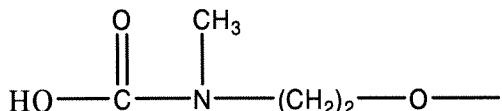
The compound referred to by the Examiner is the compound of Example 99 of US 2002/0198198 and the substitute at position X₁ of the cited compound is **(carboxymethyl-amino)-ethoxy** clearly having the following structure:



The relevant portion of the X₁ substitute according to the present invention relied upon by the Examiner to make the rejection:

(C₂) alkyl, substituted with NR^aCOOR^{4a} wherein R^a is CH₃ and R^{4a} is hydrogen;

has the following structure:



Clearly the R^a group is a substitution from the nitrogen since **hydrogen** and **CH₃** can not properly be construed to be part of the linear backbone of the molecule as would be required to generate the alleged anticipatory structure of US 2002/0198198.

In US 2002/0198198, the group at the 5'-position (the group X₁) may be X⁵R⁵ or Q1. The group Q1 may be OR². However, in US 2002/0198198 the group R⁵ is restricted to aryl, heteroaryl, cycloalkyl (optionally incorporating C=O or a heteroatom) or cycloalkenyl (optionally incorporating C=O or a heteroatom). These groups are not included in the definition of R² in the present application.

In the alternative, the group R² in US 2002/0198198 may be a lower alkyl which may be further substituted with OR⁶, COOR⁶, NR⁶R⁷, NR⁶C(=O)R⁷, C(=O)NR⁶R⁷ or SO₂NR⁶R⁷.

In the present application, the equivalent group R² is (C1-C6)alkyl which is further substituted with OR⁴, COOR⁴, NR⁴R⁵, NRC(=O)R⁴, C(=O)NR⁴R⁵ or SO₂NR⁴R⁵, and R⁴ and R⁵ are in turn (C₁-C₆) alkyl which is further substituted (in the case of R⁴) and may be further substituted (in the case of R⁵). It can be seen, therefore, that the groups R⁴ and R⁵ in the present application correspond to the groups R⁶ and R⁷ in US 2002/0198198.

However, the substituents on the groups R⁴ and R⁵ in the present application are different to those on the groups R⁶ and R⁷ in US 2002/0198198. In US 2002/0198198, the groups R⁶ and R⁷ may be hydrogen or lower alkyl which may be substituted with one to three OR, COOR or NRR⁸ wherein R and R⁸ may be hydrogen or lower alkyl.

In the present application, the substituents on the groups R⁴ and R⁵ do not include OR, COOR or NRR⁸. Additionally, as a substituent must be present on the group R⁴ in the present application, the possibility in the present application of R⁴ being unsubstituted alkyl is excluded. There is

therefore no overlap between these groups in the present application and those of US 2002/0198198.

In the alternative, as outlined above, the group R^2 in the present application may be (C_1-C_6) alkyl which must be substituted with $OC(=O)R^{4a}$, SR^{4a} , $S(=O)R^3$, NR^aCOOR^{4a} , $NR^a-C(=O)-NR^{4a}R^{5a}$, $NR^a-SO_2-NR^{4a}R^{5a}$, or $NR^a-SO_2-R^3$. These substituents are not present in the list of possible substituents for the corresponding group R^2 in US 2002/0198198. Therefore, there is no overlap between these groups in the present application and those of US 2002/0198198.

Therefore, US 2002/0198198 does not read on the presently claimed invention and the rejection is improper.

Conclusion

In view of the foregoing arguments and amendments, it is respectfully submitted that all claims now active in the present application are in condition for allowance. Therefore, passage of the application and claims to issue is respectfully requested.

Respectfully submitted,



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